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09/597,784	06/19/2000	James Crawford	06975-097001	4992

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EXAMINER
BAUGH, APRIL L

ART UNIT	PAPER NUMBER
2141	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	Application No. 09/597,784	Applicant(s) CRAWFORD, JAMES
	Examiner April L Baugh	Art Unit 2141

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-44_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-44_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _19 June 2000_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _2_ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

Claim Objections

1.   Claims 37-40 objected to because of the following informalities: claim 37 cannot depend

on itself "37. The method of claim 37" and thus claims 38-40 depend on claim 36 not claim 37.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

2.   Claim1-44 rejected under 35 U.S.C. 102(e) as being unpatentable by US Patent No.

6,513,066 to Hutton et al.

Regarding claim 1, Hutton et al. teaches a method of transferring a file from a first client

associated with a first subscriber to a communications system to a second client associated with a

second subscriber to the communications system, the method comprising: connecting from the

first client to a communications system host; sending, through the communications system host,

a request to the second client to establish a direct connection to the second client; when the

second client accepts the request, establishing a direct connection to the second client that

bypasses the communications system host; and transferring a file over the direct connection (column 1, lines 37-40 and column 2, lines 7-25).

Regarding claim 14, Hutton et al. teaches a method of transferring a file from a first client associated with a first subscriber to a communications system to a second client associated with a second subscriber to the communications system, the method comprising: connecting from the second client to a communications system host; receiving, through the communications system host, a request from the first client to establish a direct connection; accepting the request from the first client; establishing a direct connection to the first client that bypasses the communications system host; and receiving a file over the direct connection (column 1, lines 37-40 and column 2, lines 7-25).

Regarding claim 29, Hutton et al. teaches an apparatus for transferring one or more files from a first client associated with a first subscriber to a communications system to a second client associated with a second subscriber to the communications system, the apparatus comprising a first client configured to: connect from the first client to a communications system host; send through the communications system host a request to the second client to establish a direct connection to the second client; when the second client accepts the request, establish a direct connection to the second client that bypasses the communications system host; and transfer a file over the direct connection (column 1, lines 37-40 and column 2, lines 7-25).

Regarding claim 30, Hutton et al. teaches an apparatus for transferring one or more files from a first client associated with a first subscriber to a communications system to a second. client associated with a second subscriber to the communications system, the apparatus comprising a second client configured to: connect from the second client to a communications

system host; receive, through the communications system host, a request from the first client to establish a direct connection; accept the request from the first client; establish a direct connection to the first client that bypasses the communications system host; and receive a file over the direct connection (column 1, lines 37-40 and column 2, lines 7-25).

Regarding claim 31, Hutton et al. teaches a computer program, stored on a computer readable medium for transferring a file from a first client associated with a first subscriber to a communications system to a second client associated with a second subscriber to the communications system, comprising instructions for: connecting from the first client to a communications system host; sending, through the communications system host, a request to the second client to establish a direct connection to the second client; when the second client accepts the request, establishing a direct connection to the second client that bypasses the communications system host; and transferring a file over the direct connection (column 1, lines 37-40 and column 2, lines 7-25).

Regarding claim 36, Hutton et al. teaches a computer program, stored on a computer readable medium for transferring a file from a first client associated with a first subscriber to a communications system to a second client associated with a second subscriber to the communications system, comprising instructions or: connecting from the second client to a communications system host; receiving, through the communications system host, a request from the first client to establish a direct connection; accepting the request from the first client; establishing a direct connection to the first client that bypasses the communications system host; and receiving a file over the direct connection (column 1, lines 37-40 and column 2, lines 7-25).

Regarding claim 41, Hutton et al. teaches a method of communicating between a first

client associated with a first subscriber to a communications system and a second client

associated with a second subscriber to the communications system, the method comprising:

connecting from the second client to a communications system host; establishing a direct

connection to the client that bypasses the communications system host; receiving an indication

that the first subscriber using the first client is composing a message; and receiving the message

composed by the first subscriber from the first client (column 1, lines 37-40 and column 2, lines

7-25 and column 7, lines 36-39).

Regarding claims 2 and 15, Hutton et al. teaches the method of claim 1 and 14, wherein

the request is authenticated by the communications system host (column 11, lines 59-60).

Regarding claims 3 and 16, Hutton et al. teaches the method of claim 1 and 14. wherein

the second client accepts the request based on indicated preferences of the second subscriber

(column 6, lines 28-54).

Regarding claims 4 and 17, Hutton et al. teaches the method of claim 1 and 14, wherein

the direct connection is initiated by the second client (column 7, lines 66 through column 8, line

14).

Regarding claims 5 and 18, Hutton et al. teaches the method of claim 1 and 14, wherein

the direct connection to the second client is established using an IP address of the second client

(column 2, lines 20-25).

Regarding claims 6 and 19, Hutton et al. teaches the method of claim 1 and 14, further

comprising displaying a graphical user interface indicating that a direct connection to the second

client is established (column 8, lines 41-45).

Regarding claims 7, 20, and 44, Hutton et al. teaches the method of claim 1,14, and 41, wherein the communications system host comprises an instant messaging host (column 1, lines 19-21 and 46-48).

Regarding claims 8 and 21, Hutton et al. teaches the method of claim 1 and 14, wherein the file comprises a data file (column 4, lines 27-28).

Regarding claims 9 and 22, Hutton et al. teaches the method of claim 1 and 14, wherein the file comprises a text file (column 1, lines 40-42).

Regarding claims 10 and 23, Hutton et al. teaches the method of claim 1 and 14, wherein the file comprises a graphics file (column 1, lines 22-23).

Regarding claims 11 and 24, Hutton et al. teaches the method of claim 1 and 14, wherein the file comprises an audio file (column 1, lines 22-23).

Regarding claims 12 and 25, Hutton et al. teaches the method of claim 1 and 14, wherein the file comprises a video file (column 1, lines 22-23).

Regarding claims 13 and 28, Hutton et al. teaches the method of claim 1 and 14, wherein the direct connection is a socket connection (column 7, lines 21-22).

Regarding claim 26, Hutton et al. teaches the method of claim 14, further comprising receiving an indication that the first subscriber using the first client is composing a message (column 7, lines 36-39).

Regarding claim 27, Hutton et al. teaches the method of claim 26, further comprising receiving the message composed by the first subscriber from the first client (column 7, line 66 through column 8, lines 3).

Referring to claims 32 and 37, Hutton et al. teaches the method of claim 31 and 36 wherein the computer readable medium comprises a disc (column 4, lines 17-19 and 28-30).

Regarding claims 33 and 38, Hutton et al. teaches the method of claim 31 and 36 wherein the computer readable medium comprises a client device (column 3, lines 34-35).

Regarding claims 34 and 39, Hutton et al. teaches the method of claim 31 and 36 wherein the computer readable medium comprises a host device (column 3, lines 34-35).

Regarding claims 35 and 40, Hutton et al. teaches the method of claim 31 and 36 wherein the computer readable medium comprises a propagated signal (column 3, lines 17-21).

Regarding claim 42, Hutton et al. teaches the method of claim 41, wherein the indication comprises a text message (column 8, lines 41-45).

Regarding claim 43, Hutton et al. teaches the method of claim 41, wherein the indication comprises an icon (column 9, line 63 through column 10, line 12).

Conclusion

1.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art with respect to direct file transfer in general:

US Pat No. 6,449,344 to Goldfinger et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to April L Baugh whose telephone number is 703-305-5317. The examiner can normally be reached on Monday-Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Rupal D Dharia can be reached on 703-305-4003. The fax phone number for the

organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is 703-305-3900.

ALB

RUPAL DHARIA
SUPERVISORY PATENT EXAMINER